



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/503,122 02/14/00 SALTISOV

L WH-10752US

EXAMINER

PM82/0719

Dennison Associates
133 Richmond Street West Suite 301
Toronto ON M5H 2L
CANADA

AIR MAIL

SHAPIRO, J

ART UNIT

PAPER NUMBER

3651
DATE MAILED:

07/19/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/503,122

Applicant(s)

SALTSOV ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 10 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 15 is objected to because of the following informalities. It appears that Claim 15 is a duplicate of Claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2, 4, 6, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It appears that what is meant by a "serial flash module" is not fully described in the specification so as to enable one ordinarily skilled in the art to make or use the device. For example, said serial flash module could be in series with the CPU or it could be accessed serially with the CPU, or it could be accessed through a serial port.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by the phrase "to confirm the encoded software remains unchanged" at the end of the claim.

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6. Claim 6 recites the limitations "encryption" in line 6. There is insufficient antecedent basis for these limitations in the claim.

7. Claim 13 recites the limitation "receiving arrangement" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 2, 4, 6, 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by "serial flash module".

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1, 3, 11 and 9, as understood, are rejected under 35 U.S.C. 102(a) as being anticipated by Mazur et al. Mazur et al discloses a bank validator as follows.

As described in Claim 1;

1. a banknote processing channel (18);
2. a series of sensors located along said channel (note scan head in figure 8);
3. a central processing unit (1610);
4. a removable memory storage arrangement (82)

As described in Claims 3 and 11;

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5. the removable memory storage arrangement includes an electronic address available to the central processing unit, and the electronic address is used to confirm the encoded software (see col. 36, lines 33-53);

As described in Claim 9;

6. said validator includes a testing procedure (see col. 36, lines 33-53);

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 4-8, 10 and 12-15 are rejected under 35 U.S.C. 103(a) as being
us (6, 241, 069 B1) *in view of Hardy et al* unpatentable over Mazur et al. Mazur discloses the bill validator as described above.

Mazur et al does not expressly disclose the following.

As described in Claim 2;

1. said removable memory storage arrangement is a serial flash module;

As described in Claim 4;

2. a serial flash module contains information to be downloaded to the central processing unit;

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3. said central processing unit (CPU) of the validator will not allow the validator to operate if a serial flash memory module is not inserted therein;

As described in Claim 5;

4. the removable flash module contains encrypted algorithms used by the central processing unit to evaluate banknotes;
5. the CPU includes decryption software;

As described in Claim 6;

a serial flash having as follows.

6. a read only memory which includes an identification code specific to the serial flash memory module;
7. a rewritable memory containing an encrypted operating software;
8. said encrypted operating software including an encryption of at least part of said identification code;

As described in Claim 7;

9. said removable memory storage arrangement contains an encrypted information and said CPU includes a logic for using the encrypted information;

As described in Claims 8 and 14;

10. said removable memory storage arrangement provides additional memory available to said CPU;

As described in Claims 10 and 15;

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11. said removable memory storage arrangement contains encrypted algorithms used by the CPU;

As described in Claim 12;

12. said serial flash module contains information to be downloaded to the CPU;

13. said serial flash module after downloading of said information including a security feature such that said serial flash module can not be used with other validators;

As described in Claim 13;

14. said serial flash module records the electronic address of the validator when received in a receiving arrangement and only communicates with said CPU when there is a match between the recorded electronic address provided by the validator;

Hardy et al discloses the following.

(6,079,018)

As described in Claim 4;

1. a serial flash module contains information to be downloaded to the central processing unit;
2. said central processing unit (CPU) of the validator will not allow the validator to operate if a serial flash memory module is not inserted therein (see col. 3, lines 9-17);

As described in Claim 5;

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3. the removable flash module (122) contains encrypted algorithms used by the central processing unit to evaluate banknotes (see col. 9, lines 4-39);
4. the CPU includes decryption software (note that it is inherent that where encryption is used, a decryption software routine would be used in conjunction therewith);

As described in Claim 6;

a serial flash having as follows.

5. a read only memory which includes an identification code specific to the serial flash memory module;
 6. a rewritable memory containing an encrypted operating software;
 7. said encrypted operating software including an encryption of at least part of said identification code;
- (See col. 9, lines 4-39.)

As described in Claim 7;

8. said removable memory storage arrangement contains an encrypted information and said CPU includes a logic for using the encrypted information;
- (See col. 9, lines 4-39.)

As described in Claims 8 and 14;

9. said removable memory storage arrangement provides additional memory available to said CPU;

As described in Claims 10 and 15;

10. said removable memory storage arrangement contains encrypted algorithms used by the CPU;

As described in Claim 12;

11. said serial flash module contains information to be downloaded to the CPU;
12. said serial flash module after downloading of said information including a security feature such that said serial flash module can not be used with other validators (See col. 9, lines 4-39);

As described in Claim 13;

13. said serial flash module records the electronic address of the validator when received in a receiving arrangement and only communicates with said CPU when there is a match between the recorded electronic address provided by the validator (See col. 9, lines 4-39);

Both Mazur et al and Hardy et al are analogous art as they both concern the use of flash memory cards. Further, Mazur et al concerns the handling of currency, where security is considered an important element. Hardy et al also concerns security as it discloses the encryption of documents.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have used the flash memory card of Hardy et al in the bill handling system of Mazur et al.

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The suggestion/motivation would have been to use a flash memory card to "durably and securely" store information. See col. 9, lines 6-11 of Hardy et al. See also col. 35, lines 35-40 of Mazur et al.

Regarding Claim 2, note that said removable memory storage arrangement being a serial flash module is well known by those ordinarily skilled in the art as a functional equivalent to other types of flash memory, such as PCMCIA cards, or Sony Corp's Memory Stick. (See col. 35, lines 35-50.) Therefore, it would have been obvious for one ordinarily skilled in the art to have used a serial flash module as a removable flash card in the device of Mazur et al.

Therefore, it would have been obvious to combine Mazur et al with Hardy et al to obtain the invention as specified in Claims 2, 4-8, 10 and 12-15.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher P. Ellis can be reached on (703)308-2560. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-0552 for regular communications and (703)308-0552 for After Final communications.

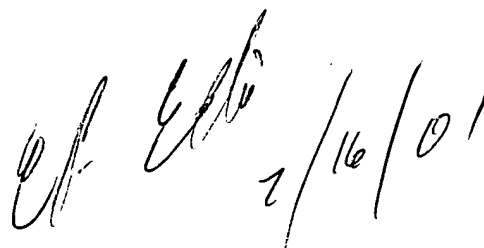
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

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Jeffrey A. Shapiro
Patent Examiner,
Art Unit 3651

July 15, 2001



CHRISTOPHER P. ELLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600